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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,330	10/31/2003	Paul A. Kohl	062020-1540	2552

24504 7590 08/17/2004

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/699,330	Applicant(s) KOHL ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

This application is up for consideration.

A.1. Claims 1-31 are generic to a plurality of disclosed patentably distinct species comprising many possible compositions (1) decomposes at a temperature range from about 100 to 120⁰C, (2) decomposes at a temperature range from about 125 to 200⁰C and (3) decomposes at a temperature range from about 100 to 120⁰C and leaves no solid residue either from the polymer or the PAG, (4) decomposes at a temperature range from about 100 to 120⁰C after exposure to ultraviolet (UV) radiation, (5) adhesive and (6) positive tone sacrificial material as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed composition species for an initiation of a search, even though this requirement is traversed. Applicants is further requested and required to additionally provide all ingredient chemical structures and their ranges of amounts ---such as 0.5 to 70.0 wt%--- of all chemical ingredient in the elected composition for a precise consideration and search by clearly and precisely disclosing (*) all bonding connections between and among chemical atoms and (**) positions of all chemical atoms in all ingredient chemical structure of the elected composition species to show the difference and distinction of the elected composition from all of others as claimed. No further examining process will be made unit all requests and requirements are met. It is now notified for the record.

2. Claims 1-31 are generic to a plurality of disclosed patentably distinct species comprising many possible sacrificial polymers as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed polymer species for an

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initiation of a search, even though this requirement is traversed. Applicants is further requested and required to additionally provide (+) the elected polymer chemical structure for a precise consideration and search by clearly and precisely disclosing (*) all bonding connections between and among chemical atoms and (**) positions of all chemical atoms in elected polymer chemical structure repeating unit species and (++) number of repeating unit monomer ---such as 50-1,000--- for the difference and distinction property elected polymer from all of others as claimed. No further examining process will be made unit all requests and requirements are met. It is now notified for the record.

3. Claims 1-31 are generic to a plurality of disclosed patentably distinct species comprising many possible photoacid generators as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed photoacid generator species for an initiation of a search, even though this requirement is traversed. Applicants is further requested and required to additionally provide the elected photoacid generator chemical structure for a precise consideration and search by clearly and precisely disclosing (*) all bonding connections between and among chemical atoms and (**) positions of all chemical atoms in elected photoacid generator chemical structure species for the difference and distinction property elected photoacid generator from all of others as claimed. No further examining process will be made unit all requests and requirements are met. It is now notified for the record.

4. Claims 1-31 are generic to a plurality of disclosed patentably distinct species comprising many possible polymers as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed polymer species for an initiation of a search, even though this requirement is traversed. Applicants is further requested and

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required to additionally provide (+) the elected polymer chemical structure for a precise consideration and search by clearly and precisely disclosing (*) all bonding connections between and among chemical atoms and (**) positions of all chemical atoms in elected polymer chemical structure species and (++) number of repeating unit monomer ---such as 50-1,000--- for the difference and distinction property elected polymer from all of others as claimed. No further examining process will be made unit all requests and requirements are met. It is now notified for the record.

5. Claims 1-31 are generic to a plurality of disclosed patentably distinct species comprising many possible negative tone photoinitiators as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed photoinitiator species for an initiation of a search, even though this requirement is traversed. Applicants is further requested and required to additionally provide the elected initiator chemical structure for a precise consideration and search by clearly and precisely disclosing (*) all bonding connections between and among chemical atoms and (**) positions of all chemical atoms in elected photoinitiator chemical structure species for the difference and distinction property elected photoinitiator from all of others including photoacid generators as claimed. No further examining process will be made unit all requests and requirements are met. It is now notified for the record.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the

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prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

B. Claims 2, 3, 4, 5, 6 and 7 are all depended on claim 1 and would have no value if they are found to be overly read on property of another claim. A double inclusion claimed embodiment is structurally invalid by itself because they are not distinct from another as required. It is now notified for the record.

Claim 4 containing "PAG" abbreviation alone is improper. The abbreviation alone is not considered. Although an embodiment in a claim is read in light of the specification, the claim must be self-supported where it is possible. Applicant are requested and required to take time and effort to spell it out. No allowance of the claim will be indicated until a proper correction is made. It is now clearly pointed out, set forth and notified for the record.

C. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a mater, ((classified in class ---, subclass ---) will be later indicated, considered and searched in accordance with the elected property as clearly set forth in "A.1" above.
- II. Claims 14-16, drawn to another patentably and distinct matter than that in Group I above, classified in class 252, at least subclass 600.
- III. Group claims (17-25) and (36-31) (with claim 17 being broadest (They are not considered to be patentably different or distinct. Therefore, separate

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consideration or search will be made. Accordingly no restriction is also made.

Should applicants disagree, urge show or provide otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made for the cord as shown or urged by applicants.), class 430, at least subclass 320+

The inventions of Groups I and II are all related to the materials but have the patentably different and distinct embodiments and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions of Groups (I and II) and Group III related fabricating a structure but it is using a matter in a process of use and not making the matter. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the matter as claimed can be used in a materially different process such as a binding two objects together and using no exposing or removing steps as claimed. Applicant should show or provide an evidence to the

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contrary. An argument alone is not a factual evidence has and may be given a little to no value. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

D. An additional consideration or search for more than one invention, class or subclass in the art is burdensome, lacks of focus on many and all issues in the claimed inventions and dilutes patentability of many and all issues in many inventions than those in one. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

E. Applicant is advised that the reply to this requirement to be complete must include full elections and requirements as set forth on the record to be examined even though the requirement be traversed (37 CFR 1.143).

F. However any process claim is permitted to be rejoined with a material claim

provided (a) that the material claim is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

G. Applicant is advised that the reply to this requirement to be complete must include full elections and requirements as clearly pointed out and set forth on the record to be examined even though the requirement be traversed (37 CFR 1.143).

H. Other issues have not been considered until full elections and requirements are met and resolved.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
11 August 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le